

### REMARKS

Claims 17 and 38-41 have been withdrawn, and new claims 46-48 have been added. Claims 42 and 44 have been amended to provide proper antecedent basis and obviate a 35 U.S.C. § 112, second paragraph, rejection. Claims 18, 24, 26-31, 33-37, and 42-48 are presented for examination.

Claims 18, 24, 26-31, 33, 34, 36, 37, and 42-45 are rejected under 35 U.S.C. § 103(a) as being unpatentable over by U.S. Patent No. 6,099,561 (Alt). The Examiner has reasoned that since Alt describes an outermost layer having an oxide, a hydroxide, or a nitrate of a noble metal, iridium oxide, or titanium nitrate, then the claimed barrier materials would have been obvious variants in view of their similar purposes and in the absence of any supposed criticality.

In disclosing an oxide, a hydroxide, or a nitrate of a noble metal, Alt has disclosed a class of materials that includes a vast number of possible materials. In addressing this situation, the Federal Circuit has stated, "The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious." (See, In re Baird, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994) (enclosed).) Here, none of the claimed barrier materials includes a noble metal so as to be encompassed by Alt's class of materials; and none of the claimed barrier materials includes or is similar to iridium oxide, the one example provided by Alt. Thus, the differences between Alt's materials and the claimed materials are even more striking than the situation addressed by the Federal Circuit.

Alt does disclose another preferred material (titanium nitrate), but this single example alone does not provide the requisite motivation to select the claimed barrier materials. Applicants note that even when obviousness is based on a single reference, the Examiner still must show a suggestion or a motivation to modify the teachings of the reference. Here, it appears that the Examiner is suggesting that Alt broadly invites one of ordinary skill to try all other ceramic materials. This obvious-to-try standard is not the appropriate standard under 35 U.S.C. § 103, and is particularly inappropriate for the present technology. The claimed devices are used in vivo and require strict biological compatibility balanced with strict mechanical performance. That is, many variables (such as strength, biocompatibility, visibility, and

compatibility with other materials) are involved in selecting a suitable material. Given these strict requirements, one skilled in the art would recognize that just because one ceramic is suitable, that not any ceramic would be suitable. Applicants request that the rejection over Alt be reconsidered and withdrawn.

Claims 18, 24, 27, 28, 33-36, 44, and 45 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,685,306 (Davidson); and claims 26, 29-31, 37, 42, and 43 under 35 U.S.C. § 103(a) as being unpatentable over Davidson. But Davidson does not disclose or suggest a device having a first portion capable of increasing the visibility of a core to *in-vivo* viewing methods, as claimed.

At best, Davidson describes a device having an alloy (e.g., Ti-Nb-Zr) core with a oxygen or nitrogen diffusion hardened surface and a ceramic coating. (See, e.g., Davidson, col. 11, lines 59-62.) The Examiner apparently equates the diffusion hardened surface with the claimed first portion. But nothing in Davidson suggests that the diffusion hardened surface is capable of increasing the visibility of the core:

The resultant oxygen diffusion hardened implants are characterized in that the oxide film contains primarily a mixture of titanium and zirconium oxides in the implant surface. Niobium oxides may also be present. Immediately underlying this mixed-oxide film is sometimes a region of oxygen-rich metal alloy. Underlying the sometimes-obtained oxygen-rich alloy layer is the core Ti--Nb--Zr alloy. The interface between the sometimes-obtained oxygen-rich alloy layer and the oxide regions is typically zirconium-rich in comparison to the underlying Ti--Nb--Zr alloy. (Id. col. 7, lines 8-18.)

On the contrary, one would expect that diffusion hardening the core would reduce the visibility of the core because formation of the oxygen-rich alloy layer consumes a portion of the core and dilutes the portion with oxygen, which has a lower atomic number than titanium, niobium, or zirconium. While Davidson mentions that an interface between the oxygen-rich alloy layer and oxide regions is typically zirconium-rich, Davidson provides no indication or suggestion (e.g., thickness or composition) that the interface is capable of increasing the visibility of the core, as claimed. Since Davidson does not disclose or suggest a device having a first portion capable of

Applicant : Verivada Chandru Chandresekran et al.  
Serial No. : 09/815,892  
Filed : March 23, 2001  
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increasing the visibility of a core to *in-vivo* viewing methods, Applicants request that the rejection be reconsidered and withdrawn.

Applicants believe the claims are in condition for allowance, which action is requested.

Enclosed is a Petition for Extension of Time with the required fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: JUNE 14, 2004

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Plaintiff points to its own actions as evidence of its apprehension of suit. For example, it cites a letter that its patent counsel sent to Defendant regarding its position that it was not infringing the '559 patent. (Pl. Br. at 8; Pl. Exh. C.)

The court is not persuaded that Plaintiff's own perceptions of Defendant's actions constitute the type of objective evidence required to prove a reasonable apprehension of suit. Rather, the "apprehension of suit" prong of the relevant test, described above, focuses on the defendant's, not plaintiff's conduct. *Arrowhead Industrial Water, Inc. v. Ecolchem, Inc.*, 846 F.2d 731, 736 [6 USPQ2d 1685] (Fed. Cir. 1988).

In conclusion, the court is not persuaded that Plaintiff has a reasonable apprehension of suit by Defendant. Defendant has not sued Plaintiff, nor threatened to sue Plaintiff, nor made any demands on Plaintiff; moreover, there has been no evidence submitted that Defendant is threatening to sue other parties who produce the same items as Plaintiff. Thus, Plaintiff has failed to indicate that there is before this court a justiciable case or controversy, permitting analysis of the propriety of declaratory judgment. Because Plaintiff has failed to indicate that it has a reasonable apprehension of suit by Defendant, the court need not address the second prong of the applicable analysis — whether or not it has actually produced or prepared to produce the allegedly infringing product. Defendant's motion will be granted. An appropriate order will be issued.

#### ORDER

In accordance with the accompanying memorandum, IT IS HEREBY ORDERED THAT:

(1) Defendant's motion to dismiss is GRANTED.

(2) The clerk of court is directed to close this case.

Court of Appeals, Federal Circuit

In re Baird

No. 93-1262

Decided January 19, 1994

#### PATENTS

##### 1. Patentability/Validity — Obviousness — Relevant prior art — Particular inventions (§115.0903.03)

Application claim for flash fusible toner is not obvious in view of prior patent, even

though generic diphenol formula of patent encompasses bisphenol A of claim, since disclosure of generic formula that may encompass claimed compound does not, without more, render compound obvious, and since generic diphenol formula of patent contains large number of variables and encompasses estimated 100 million different diphenols in addition to bisphenol, but patent does not suggest selection of specific variables to formulate that compound and specifically discloses diphenols which are different from, and more complex than, bisphenol A; prior patent's specific enumeration of derivatives of bisphenol A does not warrant contrary conclusion, since suggestion of certain complex bisphenol A derivatives does not describe or suggest bisphenol A itself and thus does not motivate its selection.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Brian W. Baird, Art F. Diaz, William H. Dickstein and Charles M. Seymour, serial no. 07/333,524 (flash fusible toner resins). From decision upholding examiner's final rejection of claims 1-5 on ground of obviousness under 35 USC 103, applicants appeal. Reversed.

John A. Brady, Lexington, Ky., for appellant.

Adriene B. Lepiane, assistant solicitor, PTO (Fred E. McKelvey, solicitor, and Richard E. Schafer, associate solicitor, with her on brief), for appellee.

Before Michel, Plager, and Lourie, circuit judges.

Lourie, J.

Applicants Brian W. Baird, Art F. Diaz, William H. Dickstein, and Charles M. Seymour (collectively Baird)<sup>1</sup> appeal from the October 15, 1992 decision of the U.S. Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences, Appeal No. 92-0860, affirming the examiner's final rejection of claims 1-5 of application Serial No. 07/333,524, entitled "Flash Fusible Toner Resins," as unpatentable on the ground of obviousness under 35 U.S.C. § 103 (1988). We reverse.

<sup>1</sup> The real party in interest is Lexmark International, Inc.

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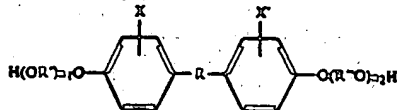
## BACKGROUND

Baird's application is directed to a flash fusible toner comprising a polyester of bisphenol A and an aliphatic dicarboxylic acid. Synthesis of the toner compositions involves the acetylation of bisphenol A and the reaction of that product with an aliphatic dicarboxylic acid selected from the group consisting of succinic acid, glutaric acid, and adipic acid. The application discloses that toners containing bisphenol A have optimal characteristics for flash fusing including, *inter alia*, high thermal stability and low critical surface energy.

Claim 1, the only claim at issue, reads as follows:

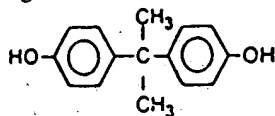
1. A flash fusible toner comprising a binder resin which is a bisphenol A polyester containing an aliphatic di[carboxylic] acid selected from the group consisting of succinic acid, glutaric acid and adipic acid.

Claim 1 stands rejected as obvious over U.S. Patent 4,634,649 to Knapp et al., which relates to developer compositions comprised of, *inter alia*, the polymeric esterification product of a dicarboxylic acid and a diphenol of the following generic formula:



wherein R is selected from substituted and unsubstituted alkylene radicals having from about 2 to about 12 carbon atoms, alkylidene radicals having from 1 to 12 carbon atoms and cycloalkylidene radicals having from 3 to 12 carbon atoms; R' and R'' are selected from substituted and unsubstituted alkylene radicals having from 2 to 12 carbon atoms, alkylene arylene radicals having from 8 to 12 carbon atoms and arylene radicals; X and X' are selected from hydrogen or an alkyl radical having from 1 to 4 carbon atoms; and each n is a number from 0 (zero) to 4.

Col. 4, lines 16-38. The Knapp formula contains a broad range of variables and thus encompasses a large number of different diphenols, one of which is bisphenol A, which is shown in Baird's application as having the following structure:



Knapp also discloses that the dicarboxylic acids have the general formula:  
 $\text{HOOCR}''n_1\text{COOH}$

wherein R'' is a substituted or unsubstituted alkylene radical having from 1 to 12 carbon atoms, arylene radicals or alkylene arylene radicals having from 10 to 12 carbon atoms and  $n_1$  is a number of less than 2.

Col. 5, lines 6-14. Twenty typical dicarboxylic acids are recited, including succinic acid, glutaric acid, and adipic acid, the dicarboxylic acids recited in claim 1.

The examiner rejected claim 1, as obvious on the ground that Knapp specifically discloses as components of his esters the three dicarboxylic acids recited in claim 1 and a generic formula which encompasses bisphenol A. Recognizing that bisphenol A is defined when certain specific variables are chosen, the examiner reasoned that bisphenol A "may be easily derived from the generic formula of the diphenol in [Knapp] and all the motivation the worker of ordinary skill in the art needs to arrive at the particular polyester of the instant claim [1] is to follow [that formula]."

The Board upheld the examiner's rejection. It rejected Baird's argument that there was no motivation for one to select bisphenol A from Knapp and summarily concluded that "the fact that [the claimed] binder resin is clearly encompassed by the generic disclosure of Knapp... provides ample motivation for the selection of [the claimed] composition." Slip op. at 3. The Board's decision was affirmed on reconsideration.

## DISCUSSION

The only issue before us is whether the record supports the Board's conclusion that, in view of the teachings of Knapp, the claimed compounds<sup>2</sup> would have been obvious to one of ordinary skill in the art. We review an obviousness determination by the Board *de novo*, while we review underlying factual findings for clear error. *In re Beattie*, 974 F.2d 1309, 1311, 24 USPQ2d 1040, 1041 (Fed. Cir. 1992).

Baird does not dispute the fact that the generic diphenol formula of Knapp encompasses bisphenol A. Nor does Baird dispute that Knapp specifically discloses the three dicarboxylic acids recited in claim 1. Rather, Baird argues that there is no suggestion in Knapp to select bisphenol A from the vast

<sup>2</sup> Since the toner, the resin, and the polyester compounds appear to be treated in the Board opinion and patent application as synonymous, and the PTO has premised its obviousness rejection on the obviousness of the compounds, we will treat this case accordingly.

formula of patent claim; since that may encompass not, without obvious; and since of patent contains and encompasses different diphenols in patent does not variables to for specifically dis- isphenol A; prior ion of derivatives warrant contrary n of certain comes does not de- A itself and thus ion.

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number of diphenols covered by the generic formula and that the Board thus erred in concluding that the claimed compounds would have been obvious.

[1] What a reference teaches is a question of fact. *Beattie*, 974 F.2d at 1311, 24 USPQ2d at 1041. The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (rejecting Commissioner's argument that "regardless [ ] how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it"). *Jones* involved an obviousness rejection of a claim to a specific compound, the 2-(2'-aminoethoxy)ethanol salt of 2-methoxy-3,6-dichlorobenzoic acid (dicamba), as obvious in view of, *inter alia*, a prior art reference disclosing a genus which admittedly encompassed the claimed salt. We reversed the Board's rejection, reasoning that the prior art reference encompassed a "potentially infinite genus" of salts of dicamba and listed several such salts, but that it did not disclose or suggest the claimed salt. *Id.*

In the instant case, the generic diphenol formula disclosed in Knapp contains a large number of variables, and we estimate that it encompasses more than 100 million different diphenols, only one of which is bisphenol A. While the Knapp formula unquestionably encompasses bisphenol A when specific variables are chosen, there is nothing in the disclosure of Knapp suggesting that one should select such variables. Indeed, Knapp appears to teach away from the selection of bisphenol A by focusing on more complex diphenols, including 2,2-bis(4-beta-hydroxyethoxyphenyl) propane, 2,2-bis(4-hydroxypropoxyphenyl) propane, and 2,2-bis(4-hydroxyisopropoxyphenyl)propane. Col. 4, lines 51-64. Knapp teaches that in preferred diphenols, R has 2 to 4 carbon atoms and R' and R'' have 3 to 4 carbon atoms, and in "optimum" diphenols, R is an isopropylidene radical, R' and R'' are selected from the group consisting of propylene and butylene radicals, and n is one. Col. 4, lines 38-47. Knapp further states that the diphenol in the preferred polyester material is 2,2-bis(4-hydroxyisopropoxyphenyl)propane. Col. 5, lines 36-38. Fifteen typical diphenols are recited. None of them, or any of the other preferred phenols recited above, is or suggests bisphenol A.

The Commissioner repeatedly emphasizes that many of the diphenols specifically enumerated in Knapp are derivatives of bisphenol A. He argues that Knapp thus sug-

gests the selection of bisphenol A itself. We disagree, because, according to the specification, the diphenol in the esters of claim 1 can only be bisphenol A, not a bisphenol A derivative. While Knapp may suggest certain complex bisphenol A derivatives, it does not describe or suggest bisphenol A and therefore does not motivate the selection of bisphenol A.

"[A] reference must be considered not only for what it expressly teaches, but also for what it fairly suggests." *In re Burckel*, 592 F.2d 1175, 1179, 201 USPQ 67, 70 (CCPA 1979). Given the vast number of diphenols encompassed by the generic diphenol formula in Knapp, and the fact that the diphenols that Knapp specifically discloses to be "typical," "preferred," and "optimum" are different from and more complex than bisphenol A, we conclude that Knapp does not teach or fairly suggest the selection of bisphenol A. *See In re Belle* 991 F.2d 781, 26 USPQ2d 1529 (Fed. Cir. 1993) (DNA sequence would not have been obvious in view of prior art reference suggesting a nearly infinite number of possibilities and failing to suggest why among all those possibilities one would seek the claimed sequence). A disclosure of millions of compounds does not render obvious a claim to three compounds, particularly when that disclosure indicates a preference leading away from the claimed compounds.

#### CONCLUSION

The Board clearly erred in finding that Knapp would have provided the requisite motivation for the selection of bisphenol A in the preparation of the claimed compounds. Accordingly, the decision of the Board affirming the rejection of claim 1 as obvious over Knapp is reversed.

#### COSTS

No costs.

#### REVERSED

#### Court of Appeals, Fifth Circuit

McGaughey v. Twentieth Century Fox Television

No. 93-1652

Decided January 20, 1994

#### COPYRIGHTS

1. Rights in copyright; infringement — Right to reproduction — Access, copying, and substantial similarity — In general (§213.0503.01)

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